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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,282	11/26/2003	Thomas Wien	11286-01250	1147

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EXAMINER

CHAN, SING P

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/724,282	Applicant(s) WIEN ET AL.	
	Examiner Sing P. Chan	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 231-244, 246-271, 273-294, 296-301, 303-344, 351-362 and 366-385 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 250-262, 271-288, 290, 297-301, 362 and 373-381 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 266, 267, 269, 270, 306-308, 313, 314, 328, 337, 382 and 385 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/04&5/23/06</u> . | 6) <input type="checkbox"/> Other: ____ |

Continuation of Disposition of Claims: Claims rejected are 231-244, 246-249, 263-265, 268, 289, 291-294, 296, 303-305, 309-312, 315-327, 329-336, 338-344, 351-361, 366-371, 383 and 384.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 289, 309, 325, 334, 343, and 371 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the diameter of the small hole or aperture is 0.656 inch but the Specification on Page 16, lines 7-8 recites the diameter of the small hole or aperture should be 0.604 inch. Therefore, the claims diameter is not recited in the Specification and is new matter.

Claim Objections

3. Claims 335, 344, and 372 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims recite the same limitation, i.e. support surface is configured to support a round

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label having a pair of opposing and outwardly extending tabs, which was also recited by claim 326.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 263-265, 268, and 296 are rejected under 35 U.S.C. 102(b) as being anticipated by Hummell et al (U.S. 5,951,819).

Regarding claims 263 and 296, Hummell et al discloses an apparatus for applying a label. The apparatus includes base with a label support surface (Col 2, lines 25-29), a plunger element with a lip element, i.e. a centering post with a spindle and an article support ledge (Col 2, lines 58-64), movable up and down relative to the base (Col 2, lines 64-67), and the base also includes an outer raised ring, which is capable of centering a label with a larger hole (See Figures 1, 3, and 4). Furthermore, the outer raised ring would center a second label with a larger hole and the centering post will allow the article supported on the centering post to be pressed down against the first or second label

Regarding claim 264, Hummell et al discloses the plunger element is one single unit with a spindle and a centering post. (Col 2, lines 58-64 and Figures 1, 3-5)

Regarding claim 265, Hummell et al discloses a spring is used for biasing the plunger element with the support ledge upward. (Col 3, lines 44-56)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 231-244, 246-249, 291-294, 303-305, and 309-312 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolosko et al (U.S. 4,000,906) in view of Miyoshi (U.S. 3,848,875).

Regarding claims 231-236, 238, 240, 241, 246-249, 291-294, 303-305, 310, 312 Kolosko et al discloses a two speed automatic phonograph. The phonograph includes a turntable driven by a two-speed drive, a centering pin for centering a record with a small aperture, and a plurality of upward directed guides to automatically center record with larger aperture. (Col 3, line 47 to Col 4, line 14 and Figure 3) These structures are considered capable of centering labels with different aperture and a disk, which satisfied the intended use of claims for supporting a label and guiding a disk onto the adhesive of the labels. Kolosko et al is silent as to the centering pin includes article support surface. However, providing an article support surface for a centering pin is well known and conventional as shown for example by Miyoshi. Miyoshi discloses a centering spindle with an article or disk support. The spindle includes an inner shaft and primary support

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(Col 14, lines 14-28), when the inner shaft is pulled downward, the primary support is gradually withdrawn within a spindle housing to release the disk or article to be pressed down onto the turntable (Col 15, lines 49-62)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the centering pin with article support as disclosed by Miyoshi in the apparatus of Kolosko et al to provide a support with automatic individual stacking of the article or disk onto the turntable. (See Miyoshi, Col 1, lines 6-14)

Regarding claim 237, Kolosko et al discloses the guides radially outward from the post or centering pin. (Figure 3)

Regarding claims 239 and 309, Kolosko et al as modified by Miyoshi is silent as to the diameter of the small hole is 0.656 or 0.604 inch and the large hole is 1.625 inch. However, one of ordinary skill in the art would appreciate providing the proper sized structure for the holes and would be logical to size the structure to fit the intended purpose of the structures.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to logically sized or position the centering structures to fit the aperture such as 0.656 inch, 0.604 inch, or 1.625 inch in the apparatus of Kolosko et al as modified by Miyoshi to allow the structure to properly centering the articles.

Regarding claims 242-244 and 311, the apparatus of Kolosko et al is considered to be capable of centering article such as CD, optical disk, and DVD.

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8. Claims 315-327, 329-336, 338-344, 351-361, 366-372, 383, and 384 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyoshi (U.S. 3,848,875) in view of Hiraki (U.S. 3,680,872).

Regarding claims 315-324, 327, 329-333, 336, 338-342, 351-361, 366-370, 383, and 384, Miyoshi discloses an apparatus for automatic record playing. The apparatus includes a turntable with a collar, i.e. a post, which is capable of centering a label of narrow opening, secured to the turntable (Col 2, lines 60-68) with the turntable providing a circular label support surface, a spindle with an inner shaft, a primary support protrudes radially outwardly outside the spindle housing to support a disk, which is capable of support an optical disk, a spring for biasing the inner shaft upward and withdrawn the inner shaft downward to withdrawn support within the spindle housing (Col 14, lines 13-28). Miyoshi is silent as to a centering ring movable in the opening of the center of the circular support surface and being concentric with the centering post. However, providing a centering ring in an opening of the center of the circular support surface is well known and conventional as shown for example by Hiraki. Hiraki discloses an embedded adapter for turntable. The adapter includes ring (6) and a plate (7) with spring (5), when plate (7) is depressed downwardly the spring tripped to spring the ring (6) upwardly above the turntable and when the ring is depressed downwardly the spring tripped to bring the plate (7) back up and level with the turntable and ring surface. (Col 2, lines 38 to Col 3, line 2)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a ring (6), a plate (7), and a spring (5) as disclosed by

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Hiraki in the apparatus of Miyoshi to provide an embedded adapter that is simple in construction and economical in production. (See Hiraki, Col 1, lines 41-44)

Regarding claims 325, 334, 343, and 371, Kolosko et al as modified by Miyoshi is silent as to the diameter of the small hole is 0.656 inch and the large hole is 1.625 inch. However, one of ordinary skill in the art would appreciate providing the proper sized structure for the holes and would be logical to size the structure to fit the intended purpose of the structures.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to logically sized or position the centering structures to fit the aperture such as 0.656 inch or 1.625 inch in the apparatus of Kolosko et al as modified by Miyoshi to allow the structure to properly centering the articles.

Regarding claims 326, 335, 344, and 372, the turntable of Miyoshi is considered capable of supporting a round label with a pair of opposing and outwardly extending tabs.

Allowable Subject Matter

9. Claims 250-255, 257-262, 271, 273-288, 290, 297-301, 362, 373-381 are allowed.

10. Claims 266, 267, 269, 270, 306-308, 313, 314, 328, 337, 382, 385 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. Claim 289 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Response to Arguments

12. Applicant's arguments with respect to claims 231, 248, 263, 303, 315, 327, 352, and 351 have been considered but are moot in view of the new ground(s) of rejection.

13. In response to applicant's argument to claim 365, the claim has been canceled therefore the argument is moot.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER
Au 1734

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Chan Sing Po

SPC